UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,943	01/31/2001	Ronald Jacoby	17887-004600US	9158

32361 7590 08/27/2007

GREENBERG TRAURIG, LLP
MET LIFE BUILDING
200 PARK AVENUE
NEW YORK, NY 10166

EXAMINER	
CARLSON, JEFFREY D	
ART UNIT	**PAPER NUMBER**
3622	
MAIL DATE	**DELIVERY MODE**
08/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/773,943	JACOBY ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/4/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 8/24/2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 8-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1, 8, 9, 12 are unclear when they state that the playlist content is "other than streaming content" yet it comprises references to streaming content. The term playlist is a term of the art referring to a list of references to media clips. Such a playlist when including references to streaming media clips is fairly described as a playlist of streaming content. Yet applicant's claims are confusing by stating there is no streaming content and then stating that there is streaming content. Applicant has included the new language to distinguish from the applied art which is argued to have actual streaming content, rather than mere references, in the bin playlist. However, applicant's language that the playlist includes *references* to content has the desired scope whether or not the playlist is also claimed to contain "other than streaming content". Applicant should delete the "other than" language as being unnecessary as well as serving to confuse rather than clarify. New

claim 16 is clear in its requirement for a playlist of references without the added confusion of "other than streaming content" and is a recommended model for the other claims in that regard.

- Claim 8 (lines 9-10) states "streaming advertisement and media content identify said streaming content" which is confusing. Perhaps a few words are missing here?

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. **Claims 1, 2, 4-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Holtz et al (US6760916).** Holtz et al qualifies as prior art under 102(e) and includes a chain of CIP applications to an earliest effective date of 1/14/2000. The parent application 09/634735 filed 8/8/2000 has been relied upon by the examiner previously in order to demonstrate full support for the teachings used against the instant claims – and will continue to be applied here. Examiner will be referring to page and line number of the specification of 09/634735 in this Office Action.

Regarding claims 1, 6, 8, 9, 12-14, 16, 19, 20, 24, Holtz et al teaches an Internet user browsing a web page in order to select media segments of a show for "on-demand"

viewing. After the user selects a plurality of desired media clips in a certain order, the system creates a "bin" playlist defining the collection of desired clips in a specific order. Each clip/segment in the collection represented by the playlist is identified (i.e. referenced by) by time code stamps and identification labels. After the playlist is complete, the streaming media referenced therein is delivered to the player in the user's browser [page 70 lines 8-23 of 09/634735]. In this manner, a playlist is created at a network source based upon requested user information (clip selection information, clip arrangement information). The playlist of Holtz et al is consistent with well accepted definitions of a playlist in that the playlist contains references to content rather than containing copies of the content. In the case of Holtz et al, the references are to requested media clips that are streamed seamlessly to the user's browser/player in a manner as defined by the bin playlist. Advertisements can actually be located elsewhere and still be referenced [page 72 lines 26-27]. The clips themselves are stored on RDP 129 and a script can be used to reference the clips by time stamp in order to retrieve the clips. When a user builds a playlist, a new script file can be created that references time stamps and appropriate time segments are inserted into the new script file. In addition, the processing unit 102 can insert additional codes into the script file to reference other data related to each media clip. These additional codes can are representative of advertising content [page 76 lines 4-20 of 09/634735]. The show script includes links (i.e. references) to advertisements which are streamed at specified intervals and duration with the video show requested [page 72 lines 20-23]; this provides applicant's claimed indicators that indicate when the advertisement should be

played in relation to the media content. Holtz et al also teaches that a second browser frame can be provided such that HTML content associated with the streaming content can be displayed simultaneously adjacent the first frame of streaming content [page 72 lines 11-19]. This auxiliary content in the second frame is taken to be HTML content at least in terms of the text described by Holtz et al and the menu of related data or web sites that a user can select [page 73 lines 25-30, page 74 lines 1-8]. Holtz et al is taken to inherently include directory construction and searching for files which define the parameters of the frames in order to properly render the frames as well as the content that is rendered within them.

Regarding claims 2, 5, 10, 11, 15, the auxiliary content synchronized with the streaming content is taken to represent embedded instructions for triggering the HTML rendering of the additional content in the data frame. Holtz et al also describes the use of datacasting at page 76 line 25.

Regarding claims 4, 7, 18, Holtz et al teaches that advertisements views are logged [page 74 lines 16-20].

Regarding claim 17, the claim depends from claim 16 which requires the playlist include a "reference to streaming advertisement content" *or* a "reference to streaming media content which has at least one embedded command including advertisement identification information." In this manner the "reference to streaming media content which has at least one embedded command including advertisement identification information" and therefore the advertisement identification information, is not positively required by the claim. Claim's 17 further description of such an optional feature does

not make the feature a requirement. Further, the "to identify" and "to be played" phrases are not positively being performed as part of the method language claimed. Nonetheless, both the streaming advertisements of Holtz et al and the auxiliary content in the data frame can be taken to be advertisements which meet the claim language provided.

Regarding claims 21, 22, the auxiliary data frame of Holtz et al is taken to change continuously over time and as the streaming media progresses and/or changes. Therefore it can be said that there are plural commands to trigger changes to the HTML content displayed in the data frame. Any of the HTML content can be taken to meet the broad "default" HTML content. If the HTML content is meant to be shown, it can be said to be the default content.

Regarding claim 23, a user request for a custom playlist based on his user profile can be said to be a request including advertisement selection information, especially where the content involved (weather, traffic, stock market, etc) can be considered to be "advertising"; the term advertising merely requires an announcement or message delivered to the public [page 71 lines 28-30, page 72 lines 1-10]. Further still, as the advertisements are also described as being tied to the streaming media content, a media content chosen based on user profile directly affects the associated advertising selected. The user profile information provides advertisement selection information included with the request. Or, the simple manual building of a playlist by a user includes media selection which drives related advertisement selection.

Regarding claim 25 - like claim 17, the language further describes what is taken to be an optional limitation. Nonetheless, the switching to ad advertisement during playback of the streaming media content is taken to read on the claim limitation provided.

Regarding claim 26, Holtz et al teaches that the streaming selections can be based upon content and/or duration [page 71 lines 29-30, page 76 lines 18-20].

Response to Arguments

Applicant argues that no showing has been made that Holtz et al is prior art. The front page of Holtz et al (US6760916) makes is rather clear that it qualifies as prior art under 102(e) as early as 1/14/2000.

Applicant argues that because the parent applications are CIPs, that they (the parents) must support the features relied upon in the rejection. Examiner agrees and previously provided citations regarding the parent 09/634735 as well as provided applicant a copy of the specification for 09/634735. Applicant now subsequently argues that there is no showing that the subject matter of Holtz et al relied upon in the rejection is not new matter. Because examiner previously cited relevant portions of 09/634735 and applicant has failed to argue any of them, Examiner can only assume that applicant is referring to the *newly submitted claim language* when it is argued that there has been no showing of support for the relied-upon subject matter. To this end examiner has written the rejection to cite to 09/634735 for the teachings relevant to eh new claim

language. Examiner has also re-drafted the rejection with all citations being made in reference to 09/634735 rather than any of US Patent 6760916.

Applicant argues that Holtz et al's bin playlist is one which includes actual content rather than references to the content. Holtz et al's system creates a "bin" playlist defining the collection of desired clips in a specific order. Each clip/segment in the collection represented by the playlist is identified (i.e. referenced by) by time code stamps and identification labels. After the playlist is complete, the streaming media referenced therein is delivered to the player in the user's browser [page 70 lines 8-23 of 09/634735]. In this manner, a playlist is created at a network source based upon requested user information (clip selection information, clip arrangement information). Advertisements can actually be located elsewhere and still be referenced [page 72 lines 26-27]. The playlist of Holtz et al is consistent with well accepted definitions of a playlist in that the playlist contains references to content rather than containing copies of the content. In the case of Holtz et al, the references are to requested media clips that are streamed seamlessly to the user's browser/player in a manner as defined by the bin playlist. A playlist is a list, which is to say an ordered set of references to something. Having a grocery list in one's pocket does not mean that the food items themselves are actually in the pocket. Same is true for Holtz et al's bin playlist – it is merely an ordered set of references to the desired content (i.e. metadata) – much as a table of contents only references chapters – much as a set of bookmarks references web pages, not stores a copy of them.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc